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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,222	09/17/2003	Matt Nordstrom	05127.00228	6277
22908	7590	01/17/2006	EXAMINER	
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			OSELE, MARK A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,222

Applicant(s)

NORDSTROM, MATT

Examiner

Mark A. Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 7-42 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10122005.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 8, 10-14, 16-19, 21-22, 24-25, 27-29, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Stahl (5,422,173). Stahl '173 teaches a method of joining a plurality of textile elements to make an article comprising the steps of: providing a first bond between a third textile element, 26, and an adhesive element, 24; forming a second bond between a second textile element, 22, and the adhesive element by applying heat and pressure between platens (column 3, lines 57-63); and attaching the joined second and third textile elements to a first textile element (column 5, lines 11-24), wherein the bond between the second and third textile elements is in a spaced relationship with the outer edges of the third textile element (Fig. 2).

Regarding claims 5-6, the first bond is located in a spaced relationship with all outer edges of the second textile element (Fig. 2).

Regarding claims 13, 21, and 33 the second and third textile elements have substantially similar dimensions (Fig. 2).

Regarding claims 14, 17-18, 27-28 the adhesive element is a thermoplastic polymer such as urethane or polyester (column 3, lines 18-19).

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Regarding claim 16, the disclosure of Stahl also anticipates the limitations wherein element 26 is the first textile element, element 22 is the second textile element which is bonded to first textile element in a spaced relationship with some of the outer edges of the second element.

Regarding claim 24, the disclosure of Stahl also anticipates the limitations wherein element 30 is the first textile element, element 26 is the second textile element which extends over the first textile element and is adhesively bonded thereto at the outer perimeter of the second element, and element 22 is the third textile element which extends over the second textile element and is attached thereto.

Regarding claim 29, the article is incorporated into an article of apparel (column 5, lines 22-24).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 15, 20, and 30-32, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (5,422,173) in view of Mahn, Sr. et al. (4,971,644). As shown in paragraph 2 above, Stahl shows all of the claimed limitations except for the textile element and garment to be made of a mesh material. Mahn, Sr. et al. teaches that sports jerseys are commonly made from a mesh material and it is desirable to have

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a number applied to the jersey. Furthermore, Mahn, Sr. et al. teaches that numbers that cover the holes in a mesh jersey are aesthetically unappealing and block air flow (column 1, lines 48-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the garment and the textile element of Stahl of a mesh material because Mahn, Sr. et al. teaches that mesh garments and applied emblems are desirable for sport uniforms.

5. Claims 9, 23, 26, 34-37, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl in view of either Conrad (3,662,878) or Castro, Jr. (5,906,006) As shown in paragraph 2 above, Stahl shows all of the claimed limitations except for the textile element to be sewn on a garment. Conrad (column 1, lines 23-26) and Castro, Jr. (column 2, lines 31-38) each teach that adhesive bonding or sewing are known for putting a textile element on a garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sew the textile element of Stahl on a garment because Conrad and Castro, Jr. each teach this to be a conventional alternative to adhesive bonding.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure does not describe how the bond can be in a spaced relationship with all of the edges of the second textile element (claim 5) while also being in a spaced relationship with at least some of the outer edges of the third textile element (claim 1). Figures 3, 4, and 14 show the bond to be in a spaced relationship with the edges of only one of the textile elements being bonded, not both.

Response to Arguments

8. Applicant's arguments filed October 12, 2005 have been fully considered but they are not persuasive. Applicant's main argument is that Stahl does not show bonding of the textile elements in such a way that the bond is spaced from some or all of the outer edges of one of the textile elements because the elements are coated on their entire rear surfaces. Although Stahl shows element 22 to be bonded on its entire rear surface to element 26 and element 26 to be bonded on its entire rear surface to element 30, the bond between element 22 and element 26 is spaced from the entire outer edge of element 26 (See Figs. 1 and 2). It is this spacing in Stahl which meets the instantly claimed limitations.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark A. Osele', is positioned above the printed name.

MARK A. OSELE
PRIMARY EXAMINER

January 9, 2006